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Application No.: 10/674999

Case No.: 58227US002

**REMARKS**

By way of the present amendment, claims 18, 21 and 25 are amended, and claims 32-41, 43-45 and 56-59 are canceled. Claims 6, 31, 42, 50 and 52 had been previously cancelled. As a result of the present amendment and previous amendments, claims 1-5 and 8-26 are now pending.

Claims 18, 21 and 25 stand rejected under 35 USC 112, second paragraph, as being indefinite. Applicants submit that the current amendments to these claims fully address the rejection, and therefore request reconsideration and withdrawal of the rejection.

Claims 32-34, 36-41, 43-45 and 56-59 stand rejected under 35 USC 102(b) as being anticipated by US 2001/0024685 (Boulton) as evidenced by US 6,661,408 (Chen), US 6,727,895 (Bottari), and US 4,622,437 (Bloom). Without acquiescing, Applicants submit that the cancellation of these rejected claims has rendered this rejection moot, and therefore request withdrawal of the rejection.

Claims 1-5, 9-19, 22 and 26 stand rejected under 35 USC 103(a) as being unpatentable over US 6,586,104 (Matsuda) in view of US 5,789,476 (Iryo). Applicants disagree.

In the Office Action, it is stated that the difference between Matsuda and the present invention is the specific surface modifier of the nanoparticles, and that Iryo teaches the use of the same surface modifiers for nanoparticles for the purpose of improving the stability/dispersity of the nanoparticles in the coating composition.

Even if the reasoning of present rejection was sound, it still does not address the feature recited in each of Applicants' pending claims that, "the composition has a viscosity suitable for applying the composition using a digital printing technique." There is nothing in Matsuda or Iryo to teach or suggest that the coating compositions they disclosed would be suitable for printing using a digital printing technique. As such, the proposed combination cannot be said to teach all the elements of Applicants' claims.

Further, while the Office Action states that the motivation for modifying the nanoparticles is to improve stability and particle dispersion, the nanoparticles and surface modification in Applicants' composition are also selected to allow the composition to be digitally printed, for example ink jet printed. Matsuda and Iryo do not appreciate the factors involved in making such a composition. For example, Applicants disclose the desirability for nanocomposite dispersions

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that show little tendency towards thixotropy, in contrast to the more typical sol-gel and colloidal compositions. The absence of such discussion in Matsuda and Iryo underscores their lack of appreciation for attaining properties suitable for the digital printing arts.

For these reasons, Applicants submit that any combination of Matsuda and Iryo, if proper, does not disclose all the elements of Applicants' claims, and therefore that a prima facie case of obviousness has not been made. Applicants request reconsideration and withdrawal of the rejection of claims 1-5, 9-19, 22 and 26 over Matsuda in view of Iryo.

Claims 20 and 21 stand rejected under 35 USC 103(a) as being unpatentable over Matsuda in view of US 6,251,486 (Chandross). Applicants disagree.

As stated above, Applicants' claims recite a composition that has a viscosity suitable for digital printing techniques. Chandross adds nothing to cure the deficiencies of the Matsuda reference. As such, Applicants submit that any combination of Matsuda and Chandross, if proper, does not disclose all the elements of Applicants' claims, and therefore that a prima facie case of obviousness has not been made. Applicants request reconsideration and withdrawal of the rejection of claims 20 and 21 over Matsuda in view of Chandross.

Claims 1-5, 8, 10-15, 18, 19 and 22-26 stand rejected under 35 USC 103(a) as being unpatentable over Matsuda in view of US 4,909,852 (Atkinson). Applicants disagree.

As stated above, Applicants' claims recite a composition that has a viscosity suitable for digital printing techniques. Atkinson adds nothing to cure the deficiencies of the Matsuda reference. As such, Applicants submit that any combination of Matsuda and Atkinson, if proper, does not disclose all the elements of Applicants' claims, and therefore that a prima facie case of obviousness has not been made. Applicants request reconsideration and withdrawal of the rejection of claims 1-5, 8, 10-15, 18, 19 and 22-26 over Matsuda in view of Atkinson.

Claims 16-18 stand rejected under 35 USC 103(a) as being unpatentable over Matsuda in view of US 4,173,490 (Rotenberg). Applicants disagree.

As stated above, Applicants' claims recite a composition that has a viscosity suitable for digital printing techniques. Rotenberg adds nothing to cure the deficiencies of the Matsuda reference. As such, Applicants submit that any combination of Matsuda and Rotenberg, if proper, does not disclose all the elements of Applicants' claims, and therefore that a prima facie case of

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obviousness has not been made. Applicants request reconsideration and withdrawal of the rejection of claims 16-18 over Matsuda in view of Rotenberg.


Claim 35 stands rejected under 35 USC 103(a) as being unpatentable over Boulton in view of US 2005/0007349 (Vakil). Without acquiescing, Applicants submit that the cancellation of these rejected claims has rendered this rejection moot, and therefore request withdrawal of the rejection.

Applicants submit that claims 1-5 and 8-26 are in condition for allowance, and request early indication of the same.

Respectfully submitted,

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Date

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